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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,248	08/20/2003	Mark Timothy Bennett	102792-158	7552
27389	7590	06/07/2010		
PARFOMAK, ANDREW N. NORRIS MCLAUGHLIN & MARCUS PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022				
EXAMINER				
NGUYEN, TRI V				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/07/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/645,248

**Applicant(s)**

BENNETT ET AL.

**Examiner**

TRI V. NGUYEN

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 1950.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-45 is/are pending in the application.
- 4a) Of the above claim(s) 37 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-36, 38-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/10/2010 has been entered.

### ***Response to Amendment***

2. Upon the amendment filed on 5/20/2010, Claims 30-45 are added; Claims 37 and 45 are withdrawn and Claims 1-29 are cancelled. The currently pending claims are Claims 30-45.

Applicants' remarks and amendments have been carefully considered; however, they are not found persuasive and the rejections of the new claims are based on the previously cited preferences. It is noted that the limitation of the 1Log10 of Polivirus(I) reduction is not directly linked to the specific composition.

The 112 rejections of claims 25 and 26 are mooted based on the cancellation of the claims.

### ***Election/Restrictions***

3. Newly submitted claims 37 and 45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to processes while the instant claims are directed to compositions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 37 and 45 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102 & 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 30-36 and 38-44 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zhou et al. (US 6080387).

Zhou et al. teach an antimicrobial hard surface cleaner. See col.3, ln.8.

Regarding the claimed hard surface treatment composition comprising: an alcohol constituent selected from the group consisting of methanol, ethanol, n- propanol, isopropanol, n- butanol, benzyl alcohol, and mixtures thereof which is present in an amount of from about 40 and 70 weight percent; Zhou et al. teach (col.6) that the alkanol can be selected from methanol, ethanol, n-propanol, "isopropanol," the various positional isomers of butanol, pentanol, and hexanol, and mixtures of the foregoing.

Zhou et al. motivate one of ordinary skill to preferentially utilize ethanol, which advantageously acts as both a solvent, to maintain the ingredients in the liquid composition in dispersion, as well as a disinfectant. If mixtures of solvents are used, the amounts and ratios of such solvents used are important to determine the optimum performances of the inventive composition. It is preferred to have the total amount of solvent to at least 20%, more preferably least 30%, and most preferably, at least 50%, of the composition. A preferred range is about 20-99.9%. These amounts of solvents are generally referred to as dispersion effective or solubilizing effective amounts, since the other components, such as surfactants, are materials which are assisted into solution by the solvents. As in the case of ethanol, the solvent can also

have disinfectancy capacity itself. Finally, the solvent is also important as a cleaning material itself, helping to loosen and solubilize certain soils for easy removal from the surface treated. See col.6, ln.15-40.

Regarding the claimed pH adjusting agent such that the pH range of the composition is from about 7.0 to about 13.0; Zhou et al. teach (col.9) the utility of pH buffering agents to maintain a constant pH (which for the invention is between about 5- 14, more preferably between about 8-13; formulations containing the tri-potassium and/or tri-ammonium salts will naturally be at a lower end of the range as compared to the corresponding tetra salts). These buffers include, for example, NaOH, KOH, Na.sub.2 CO.sub.3, and K.sub.2 CO.sub.3 as alkaline buffers, and phosphoric, hydrochloric, sulfuric, and citric acids as acidic buffers. See col.9, ln.10-20.

Regarding the optional, one or more constituents selected from the group consisting of antimicrobials, corrosion inhibitors, perfumes, perfume carriers, deodorants, organic solvents, surfactants, propellants, pH buffers, organic acids, fungicides, film-forming polymers, and antioxidants; and water, to 100 weight percent, Zhou et al. teach the aerosol formulation comprises an antimicrobial composition that is mixed with a propellant. The composition has the following ingredients: (a) an anionic polymer or prepolymer; (b) a quaternary ammonium compound, the components (a) and (b) combining to form an antimicrobially effective complex; (c) at least one water-soluble or dispersible organic solvent having a vapor pressure of at least 0.001 mm Hg at 25.degree. C., said at least one organic solvent present in a solubilizing--or dispersion--effective amount; (d) an effective amount of a propellant; and (e) the remainder, water. See abstract and col.1, ln.60-col.2,ln.5.

Regarding the claimed antimicrobial efficacy against one or more of: *Pseudomonas aeruginosa*, *Enterococcus hirae*, *Aspergillus niger*, *T. mentagrophytes*, Hepatitis A, Poliovirus

Type 1, Coxsachievirus, Rotavirus, or Rhinovirus: Zhou et al. illustrate by example in col.11-12, the prior art composition comprising Buffer (NaOH) 0.007 Dispersing/emulsifying/wetting agent 0.03 Fragrance 0.25 Corrosion Inhibitor 0.6 Quaternary Ammonium Compound 0.63 Anionic Polymer 1.05 Propellant 10 Water 122.433 Ethanol 65 Total % by weight =100 resulting in complete inactivation of each of the viruses in table II, and each of the fungi in table III (which encompass the claimed virucidal activity to Poliovirus Type 1 and antifungal activity to *Aspergillus niger*, and *T. mentagrophytes*).

Regarding the Poliovirus reduction properties of the alcohol, it is noted that the Zhou et al. reference does not explicitly disclose the claimed properties; however, the Zhou et al. reference teaches each of the ingredients within the same proportion and pH ranges; thus the properties of the composition would inherently stem from the ingredients within the composition. Furthermore, it is noted that the court has held that that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir.1990).

It is noted that, according to MPEP 2173.05(i), the "mere absence of a positive recitation is not basis for an exclusion" - thus, the presence of anionic component or film-forming property are not precluded in the instant claims. Furthermore, it is noted that the dual component is not precluded in the instant claims.

Accordingly, the reference anticipates the material limitations of the listed claims. It is noted that the Zhou et al. reference teaches the same components within the same ranges and chemical environment, thus the same chemical behavior would be present.

6. Claims 30-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kitzke et al. (US 3282776).

Kitzke et al. teach a composition that includes (a) at least 10% of water; (b) a propellant; (c) 60 to 65% of ethanol; (d) a quarternary ammonium germicide compound; (d) a surfactant and additives (col 2, lines 38-48; col. 3, lines 4-13; col 5, line 74 to col 6, line 39; col 7, lines 8-65; col 9, lines 19-42 and examples & tables starting on col 12, line 59). Furthermore, Kitzke et al. teach the pH in the range of about 9 to about 11 (col 7, lines 69-71).

Accordingly, the reference anticipates the material limitations of the listed claims.

Regarding the various claimed properties such as the Poliovirus and antimicrobial efficacy, Kitzke et al. do not explicitly teach the claimed efficacy; however, it is noted that the court has held that that a material and its properties are inseparable (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir.1990)). Thus it would be expected that similar compositions with similar ingredients would exhibit similar chemical behaviors - in the instant case, the same efficacy. Also, it is noted that the reference teaches each of the claimed ingredients within the claimed proportions and pH ranges and such modifications are recognized as being well within the purview of the skilled artisan to yield predictable results.

7. Claims 38-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuominen et al. (US 4695453) in view of Zhou et al. (US 6080387) or Klitzke (US 3282776).

Tuominen et al. teach a composition that includes between about 40 to 50% by wt of ethanol, about 20-30 % wt of isopropanol, a nominal amount of benzyl alcohol and water (col 2, lines 15-22). It is noted that the amount of thickener is variable depending on the desired thickness (col 3, lines 37-42), thus the absence of a thickener would be an obvious possible formulation for a skilled artisan.

The Tuominen et al. reference discloses the claimed invention but does not explicitly disclose the pH features. The Zhou et al. or Klitzke reference teaches that the basic pH feature

is a well-known in hard surface cleaning composition (Zhou et al: col 9, lines 7-14 or Klitzke: col 7, lines 69-71) to gain the benefit of improved performance, stability or aesthetic qualities for the composition. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the basic pH feature in the composition taught by the Tuominen et al. reference.

Regarding the various claimed properties such as the Poliovirus and antimicrobial efficacy, Tuominen et al. and Zhou et al. or Klitzke references do not explicitly teach the claimed efficacy; however, it is noted that the court has held that that a material and its properties are inseparable (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir.1990)). Thus it would be expected that similar compositions with similar ingredients would exhibit similar chemical behaviors - in the instant case, the same efficacy. Also, it is noted that the reference teaches each of the claimed ingredients within the claimed proportions and pH ranges and such modifications are recognized as being well within the purview of the skilled artisan to yield predictable results.

### ***Response to Arguments***

8. Applicant's arguments filed 5/20/10 have been fully considered but they are not persuasive. It is noted that though the "consisting of" transitional is present in claim 30 and 38, the claim is open ended based on the optional components limitation. Furthermore, it is noted that the 1 log<sub>10</sub> limitation is not restricted to specific components but to the whole composition.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRI V. NGUYEN whose telephone number is (571)272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. V. N./  
Examiner, Art Unit 1796  
June 4, 2010

/Lorna M Douyon/  
Primary Examiner, Art Unit 1796